

REMARKS

This response follows the non-final Office Action dated March 31, 2008, and a personal interview with the Examiner on May 13, 2008. During the interview, Applicant discussed the fact that neither of the references cited against the pending claims disclose an overhead conveyor, arranged as required in the claims (or the claimed “means” so-arranged, in the case of claim 109). Although it is believed the Examiner agreed with this proposition, the suggestion was made to add “functional” language to specify more clearly the functions performed by the various structures recited. Upon considering the foregoing amendments in connection with the following remarks, it is believed the Examiner will agree that all pending claims recite patentable subject matter and thus should be allowed.

In the Office Action to which this document is responsive, the Examiner refers to certain of the “means plus function” limitations in the claims. Although the Examiner finds that the “means for folding” of claims 1 and 109 and the “means for providing and conveying” of claim 109 “meet the analysis set forth in MPEP 2181 for invoking treatment under Section 112, sixth paragraph, “the examiner does not know what the ‘means for providing a conveying path having an L-shape in plan view’” comprises “as the conveyors themselves provide the conveying path.”

As observed in *Biomedine LLC v. Waters Technologies Corp.*, 83 USPQ2d 1118 (Fed. Cir. 2007), the requirement for Section 112 compliance is “not a high bar.” Thus, “all one needs to do in order to obtain the benefit of [§ 112, ¶ 6] is to recite some structure corresponding to the means in the specification” Applicant respectfully submits that, according to the specification, it is a particular structure of the conveyors that provide the L-conveying path, namely, the stable support structures along which the cartons are conveyed. This structure is clearly linked and associated with this function in claim 110. The “means for conveying” the cartons comprises the conveyors, as a surface cannot *per se* convey anything. Thus, Applicant submits that the structures for performing the associated functions recited in the claim are perfectly clear.

Nonetheless, Applicant presents an amendment to eliminate the allegedly objectionable “means plus function” limitation, and instead recite a support surface. The amendment is considered non-narrowing, since the proper interpretation of the original limitation requires the support surface now claimed. Accordingly, the issue raised by the Examiner has been fully addressed, and

withdrawal of the rejection under 35 U.S.C. § 112, second paragraph is believed to be in order.

The Examiner also states in the Action that “limitations cannot be further modified.” Applicant is unsure of the reason for this statement, or where it finds any support in the Manual of Patent Examining Procedure or the law. Applicant believes it is free to modify limitations of the claims, as long as there is at least implicit support for the modification in the specification.

Substantively, it is contended that claims 109-110 and 112 are “anticipated” by U.S. Patent No. 3,187,482 to Steele. In order for these rejections to be proper, Steele must expressly or inherently disclose the exact same inventions, arranged precisely as required in these claims. See *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989) (“The identical invention must be shown in as complete detail as is contained in the...claim.”). Moreover, it is axiomatic that “[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). The possibility, or even probability, that the claimed structural arrangement exists in a reference is inadequate to meet the “strict identity” requirement for a proper anticipation rejection. See *Continental Can Company USA v. Monsanto Company*, 948 F.2d 1264, 20 USPQ2d 1746 (Fed. Cir. 1991) (holding anticipation “may not be established by probabilities or possibilities”).

In making this rejection, the Examiner states as follows:

Steele discloses a machine for folding boxes comprising lug conveyors c and e in an L-shaped plan; see figure 1 with a takeaway conveyor comprising parallel conveyor chains h,i, 168, and 169 located adjacent and perpendicular to one another; folding means/stationary plows 57 and rollers j, k for first and second flaps respectively; adhesive applicator means n; see figure 1. Lugs are considered retracted and upstanding to selectively engage conveyors.

Even if the foregoing is true, Steele does not disclose that the “means for conveying” is “overlying the second portion” of the claimed support surface. Since Steele does not disclose this limitation of claim 109, it cannot disclose the exact same invention of this claim or its dependent claims for purposes of an anticipation rejection under Section 102(b).

Claims 1-6, 9, 106-108, and 111 stand rejected as obvious in view of Steele. To reject properly claims under 35 U.S.C. § 103, “the examiner bears the initial burden of presenting a prima facie case of obviousness.” *In re Rijckaert*, 9 F.3d 1531, 1532 (Fed. Cir. 1993) (citing *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992)). “A prima facie case of obviousness is established when the

teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783 (Fed. Cir. 1993) (quoting *In re Rinehart*, 531 F.2d 1048, 1051 (CCPA 1976)).

In making the instant rejection, the Examiner admits that the “first conveyor c is not directly disclosed as an overhead conveyor however Steele notes that containers are fed from the closing apparatus ‘upon a lugged link belt or other appropriate conveyor c.’” Again, even if this characterization of Steele’s teachings is correct, absolutely no mention of the claimed overhead conveyor is made, which is expressly admitted, nor does the Action supply any reason as to why such an overhead conveyor would be used in the Steele arrangement. Thus, it has not been proven that “the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art,” and therefore a *prima facie* case of obviousness is lacking. *In re Bell*, *supra*.

Claim 2 also stands rejected over Steele. This claim requires that the first lug of the overhead conveyor is pivotally mounted to a conveyor chain for moving between a retracted position overlying a portion of the support surface and the depending position. Nowhere does Steele mention any “pivotally mounted” lugs, and the Examiner does not contend otherwise. Hence, favorable reconsideration of this claim is in order.

Also rejected as “obvious” is claim 3, which requires that a “second lug” is pivotally mounted to each of a pair of conveyor chains. Even assuming for the sake of argument that the belts of Steele qualify as the claimed generally parallel chains, no mention is made of any “pivotally mounted” lugs. Accordingly, a *prima facie* obviousness rejection is lacking for this claim as well.

Claim 4 requires that “each second lug” of claim 4 is “a pop-up lug movable between a retracted position below the conveying path and an upstanding position.” None of the lugs associated with the allegedly “parallel” chains “pop-up” between a retracted position “below the conveying path” and an upstanding position. Hence, a *prima facie* case of obviousness is lacking with respect to this claim as well.

In rejecting claim 5, the Examiner takes “Official Notice” that “rotatable wheels with radially extending projections are well known in the art for closing flaps.” Applicant agrees. Regardless, no reason is provided as to why it would be “obvious” to use such a rotatable wheel in the

arrangement claimed, as well as “before or during the engagement of the carton by the depending lug of the overhead conveyor.” Thus, a *prima facie* case of obviousness has not been established.

Claim 106 requires that “a portion of the overhead conveyor overlies a portion of the takeaway conveyor.” In rejecting this claim, the Examiner states that “the conveyor c” of Steele “extends beyond” the takeaway conveyor e” and “therefore an overhead conveyor in the same position would overlie the other as claimed.” First of all, Applicant again notes that Steele does not disclose the claimed overhead conveyor, and no reason is provided for so-modifying the reference to arrive at the invention of this claim. Secondly, that the takeaway conveyor “c” extends beyond conveyor “e” does not mean that the two would “overlie” each other. Hence, the statement of rejection relies on a *non sequitur*, and cannot be sustained.

Claim 107 requires not only the “overhead conveyor,” but also that the lugs it carries are “for selectively pivoting relative to the first endless chain from a retracted position to a depending position for engaging and conveying the carton along the first leg of the L-shaped path.” No overhead conveyor is even remotely mentioned in Steele, let alone one having the claimed pivoting lugs. Thus, a *prima facie* case of obviousness is lacking with respect to this claim and claim 108 depending from it.

As an alternative ground of rejection, the Examiner combines the teachings of Steele with those of U.S. Patent No. 5,638,659 to Moncrief et al. (“Moncrief”) to conclude that the inventions of claims 4, 107, and 108 are obvious. In making the rejection, the Examiner contends that the lugs of Steele “pop-up/pivot into and out of the conveying path via rotation,” and further that “pop-up lugs 63 are known in the art” as evidenced by Moncrief. Thus, it allegedly would have been “obvious . . . to use pop-up lugs as taught by Moncrief in the invention to Steele in order to further the transport of the containers when desired.”

As a first observation, this statement is internally inconsistent. If Steele teaches pop-up lugs, then it is unclear why a skilled artisan would even use the “pop-up lugs as taught by Moncrief et al. . . . to further the transport of the containers.” If this rejection is maintained, Applicant respectfully requests clarification of the rejection.

Secondly, no reason is provided at all for combining the teachings of these references. The Examiner simply states that it would be obvious to do so “to further the transport the containers.”

This is not the articulated reasoning based on a rational underpinning necessary to sustain a proper obviousness rejection. *See KSR Int'l Co. v. Teleflex, Inc.*, 82 USPQ2D 1385 (U.S. 2007).

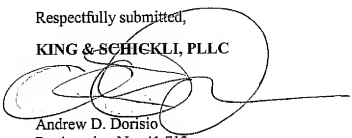
Claim 4 by virtue of its dependency on claim 1 and claims 107-108 require lugs capable of “selectively pivoting . . . from a retracted position to a depending position” for engaging the carton. Neither Steele nor Moncreif et al. disclose any lugs in a **depending** position for engaging and conveying anything. Thus, there is no substantial evidence in the record supporting the proposition that the “teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art.” *In re Bell, supra*.

Finally, new claim 113 recites the overhead and takeaway conveyor configuration, including a first folder for folding a first flap of the carton while conveyed by the overhead conveyor and a second folder for folding a second flap of the carton while conveyed by the takeaway conveyor. The conveyor c of Steele allegedly forming the “overhead” conveyor is not associated with any folder whatsoever. Moncreif does not disclose, teach, or even remotely suggest the claimed invention, either. Accordingly, favorable treatment of this new claim is in order.

Summarizing, Applicant respectfully submits that all claims presented patentably distinguish over the cited references. Accordingly, a Notice of Allowance is in order. If any other issues remain, the Examiner is invited to call the undersigned representative, and is authorized to debit any fees due from Deposit Account 11-0978.

Respectfully submitted,

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